



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/784,941	02/15/2001	Ned M. Smith	42390P10462	4183

8791 7590 11/29/2005

BLAKELY SOKOLOFF TAYLOR & ZAFMAN
12400 WILSHIRE BOULEVARD
SEVENTH FLOOR
LOS ANGELES, CA 90025-1030

EXAMINER

HOMAYOUNMEHR, FARID

ART UNIT PAPER NUMBER

2132

DATE MAILED: 11/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/784,941	SMITH ET AL.	
	Examiner	Art Unit	
	Farid Homayounmehr	2132	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 29 April 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) 3, 8 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1, 2, 4-7, 9-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to communications: application 09784941, filed 2/15/2001; amendment filed 4/29/2005.
2. Claims 1, 2 4-7, 9- 19 are pending in the case. Claims 3,8 are cancelled.

Response to Arguments

3. Applicant's arguments filed 4/29/2005 have been fully considered.
 - 3.1. Rejections under 35 USC 112 are withdrawn from claims 1-19, because the objected limitations were removed due to amendments to claims.
 - 3.2. Applicant's arguments with respect to double patenting have been fully considered and are persuasive. Double patenting rejection is withdrawn.
 - 3.3. Applicant's arguments with respect to rejections under 35 USC 103(a) have been fully considered, but are not persuasive. See the following section for detailed explanation of claim limitations based on the referenced prior art, which includes new limitations from the amended claims.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1, 2, 4-7, 9-19 rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Application Publication 2001/0021928 A1 to Ludwig (referenced cited in the office action dated 4/6/2005).

5.1. As per claim 1, Ludwig is directed to a method of enforcing authorization in a shared process between at least two parties (paragraph 3 and paragraph 14 line 1) comprising:

identifying a sender of a message requesting an action as part of the shared process;

determining the party of the sender;

associating the sender's party with a business relationship between the

sender's party and the receiver's party as defined by an electronic contract, (Sender

identity, its party and the business relationship between the sender's party and

receiver's part are all identified in the role certificates. As described in paragraph

52, during the process of creating the role certificates, signatories have checked

the details of transaction before signing it. The details of transaction, as indicated in item 66 of Fig. 6, include the name of requestor (sender name) and its party (the company, as shown in item 64 of Fig. 6). The transaction detail of form signature model used by Ludwig also makes an association between sender party and the business relationship between parties, as described in paragraph 11), the electronic contract binding public keys for each of the parties with sub-processes of the shared process to assert a relationship of trust between the parties (Fig. 10 and paragraph 65 indicating use of keys to authenticate certificate owners and prove their authority to perform transactions); identifying terms and conditions of the electronic contract corresponding to the shared process; and verifying that the requested action corresponds to the terms and conditions and is allowable for the shared process by the sender (terms and conditions are all reflected in the role certificates, and verified as described in paragraphs 52 and 86).

5.2. As per claim 2, Ludwig is directed to the method of claim 1, wherein verifying comprises at least one of using roles to determine that requested actions are sanctioned under the electronic contract, using digital certificates to determine processing systems implementing requested actions are authorized by the parties, and using public keys of the parties to verify adherence to the electronic contract (see paragraphs 52 and 86).

5.3. Claim 3 is cancelled.

5.4. As per claim 4, Ludwig is directed to the method of claim 1, wherein at least a portion of the electronic contract is digitally signed by the at least two parties with their respective public keys prior to the sender sending the message (paragraph 115).

5.5. As per claim 5, Ludwig is directed to the method of claim 1, wherein the shared process is defined by Extended Markup language (XML lets web developers create customized tags that offer greater flexibility in presenting information than HTML. Ludwig uses HTML in presenting his transactions (paragraph 54). At the time of invention, it would have been obvious to a person skilled in art to use XML instead of HTML. The motivation would be benefiting from greater flexibility of XML.)

5.6. As per claim 6, Ludwig is directed to the method of claim 1, wherein verifying comprises qualifying semantics of security related decisions affecting the shared process using information from the electronic contract (paragraph 86).

5.7. As per claim 7, Ludwig is directed to an article comprising: a storage medium having a plurality of machine readable instructions, wherein when the instructions are executed by a processor (Fig. 1 and 2 and paragraphs 36 to 42), the instructions provide for enforcing authorization in a shared process between at least two parties by identifying a sender of a message requesting an action as part of the shared process,

determining the party of the sender, associating the sender's party with a business relationship between the sender's party and the receiver's party as defined by an electronic contract (Sender identity, its party and the business relationship between the sender's party and receiver's part are all identified in the role certificates. As described in paragraph 52, during the process of creating the role certificates, signatories have checked the details of transaction before signing it. The details of transaction, as indicated in item 66 of Fig. 6, include the name of requestor (sender name) and its party (the company, as shown in item 64 of Fig. 6), the electronic contract binding public keys for each of the parties with sub-processes of the shared process to assert a relationship of trust between the parties (Fig. 10 and paragraph 65 indicating use of keys to authenticate certificate owners and prove their authority to perform transactions), identifying terms and conditions of the electronic contract corresponding to the shared process, and verifying that the requested action corresponds to the terms and conditions and is allowable for the shared process by the sender (terms and conditions are all reflected in the role certificates, and verified as described in paragraphs 52 and 86).

5.8. Claim 8 is cancelled.

5.9. As per claim 9, Ludwig is directed to the article of claim 7, wherein the electronic contract is digitally signed by the at least two parties with their respective public keys prior to the sender sending the message (paragraph 115).

5.10. As per claim 10, Ludwig is directed to an electronic contract (role certificate as described in paragraph 65) associating at least two parties with a shared process (paragraph 6) comprising: a first section to specify at least one party, other than the at least two parties, that represents a name space corresponding to a domain of cryptographic keys (in Fig. 10 the Transaction Authority is shown as one of the fields in the Role Certificate. The Transaction Authority represents the domain of keys, as described in paragraphs 93 and 11);

a second section to associate the at least two parties liable under the electronic contract with a public key of a cryptographic key pair from the domain for each of the at least two parties (Fig 10 item 120 which associates the user with the role certificate, see paragraph 65),

a third section to provide at least one of mapping of role names and sub-processes of the shared process, the electronic contract binding public keys for each of the parties with sub-processes (Fig. 10 and paragraph 65 indicating use of keys to authenticate certificate owners and prove their authority to perform transactions, also see response to claim 1);

and a fourth section to allow each of the at least two parties to digitally sign at least a portion of the electronic contract with a private key of the cryptographic key pair for each of the at least two parties (paragraph 115).

Art Unit: 2132

5.11. As per claim 11, Ludwig is directed to the electronic contract of claim 10, further comprising a fifth section to specify information identifying at least one of the electronic contract and current revision level (As described in paragraph 65, the role certificate consist of several sections, one of which is administrative information. It would be obvious to a person skilled in art to use that section for any administrative information such as contract identification and current revision level).

5.12. As per claim 12, Ludwig is directed to an electronic contract of claim 10, wherein the first section specifies a security standard used for unambiguous references to process definitions, protocols and names from which syntax and semantics of shared processes are derived (process definitions, protocols and names from which syntax and semantics of shared processes are derived can be all identified in the Transaction Authority, which is part of the Role Certificate. It would be obvious to a person skilled in art to use that field to point out security standards to identify protocols and process definitions, as exemplified in paragraph 7).

5.13. As per claim 13, Ludwig is directed to the electronic contract of claim 10, wherein the second section comprises at least one of a contract identifier, validity period, creation date, and contact information of the at least two parties (As described in paragraph 65, the role certificate consist of several sections, one of which is administrative information. It would be obvious to a person skilled in art to use that

Art Unit: 2132

section for any administrative information such as contract identifier, validity period, creation date, and contact information of the at least two parties).

5.14. As per claim 14, Ludwig is directed to the electronic contract of claim 10, wherein the third section comprises information to specify syntax and semantics of role names (Fig. 10 item 122 and associated text).

5.15. As per claim 15, Ludwig is directed to the electronic contract of claim 10, further comprising a sixth section defining ancillary services used in support of the shared process (As described in paragraph 65, the role certificate consist of several sections, one of which is administrative information. It would be obvious to a person skilled in art to use that section for ancillary services).

5.16. As per claim 16, Ludwig is directed to the electronic contract of claim 15, wherein the ancillary services comprise saving archives relating to use of the shared process by the at least two parties (Ludwig suggests use of HTML forms to conduct transactions. Saving of archives can be initiated using HTML forms).

5.17. As per claim 17, Ludwig is directed to the electronic contract of claim 15, wherein the ancillary services comprise performing audits relating to use of the shared process by the at least two parties ((Ludwig suggests use of HTML forms to conduct transactions. Auditing can be initiated using HTML forms).

5.18. As per claim 18, Ludwig is directed to the electronic contract of claim 15, wherein the ancillary services comprise timestamping the electronic contract (Ludwig suggests use of HTML forms to conduct transactions. Timestamping can be initiated using HTML forms).

5.19. As per claim 19, Ludwig is directed to the electronic contract of claim 15, wherein the sixth section specifies a party, other than the at least two parties, that provides the ancillary services to the at least two parties as part of the shared process (Ludwig suggests use of HTML forms to conduct transactions. A party that provides ancillary services can be identified using HTML forms).

Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Farid Homayounmehr whose telephone number is (571) 272-3937. The examiner can be normally reached on 9 hrs Mon-Fri, off Monday biweekly.

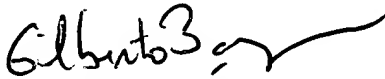
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barron can be reached on (571) 272-3799. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2132

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Farid Homayounmehr

11/1/2005


GILBERTO BARRON JR.
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100